

REMARKS

Claims 1-5, 7-19, 21 and 22 were examined. All claims were rejected. In response to the above-identified Final Office Action, Applicant amends claims 1, 2 and 10, but does not cancel any claims or add any new claims. Reconsideration of the rejected claims in light of the aforementioned amendments and the following remarks is requested.

I. Claims Rejected Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-5, 7-19, 21 and 22 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,623,637 issued to Jones *et al.* ("*Jones*") in view of U.S. Patent No. 5,754,821 issued to Cripe *et al.* ("*Cripe*"). Applicant believes the references of record fail to teach or suggest every limitation of the rejected claims.

As to claim 1, that claim recites a method comprising a number of operations, including providing a partition on an IDE storage device of a computer system. *Jones* is said to teach or suggest various elements of claim 1, but Applicant has been unable to find any teaching or suggestion in *Jones* of providing a partition on an IDE storage device – *Jones* is exclusively concerned with storage on PCMCIA devices. The secondary reference, *Cripe*, discusses a method of providing access to a "direct access storage device," but the only such device actually discussed is a SCSI disk. Furthermore, the method disclosed in *Cripe* is only applicable in the specific context of a SCSI disk connected to a computer by a SCSI adapter, because it relies on an undocumented SCSI adapter command to perform an essential step. Thus, neither *Jones* nor *Cripe* teach or suggest at least the limitation of claim 1 of providing a partition on an IDE storage device of a computer system.

Furthermore, Applicant submits that substituting an IDE storage device for *Jones*' PCMCIA device or *Cripe*'s SCSI disk is not a mere obvious modification. *Jones*' method is designed to protect information on a compact, easily transportable storage device such as a smart card. IDE storage devices, by contrast, are generally larger, heavier, and permanently connected to a single computer. There is no suggestion in either reference that an IDE disk would be a favorable or effective replacement for a portable PCMCIA

card. The prior art must suggest the desirability of the claimed invention. MPEP § 2143.01.

Also, replacing *Cripe's* SCSI disk with an IDE storage device would render *Cripe's* method unworkable. Either the SCSI adapter would be unable to communicate with the IDE disk, or the IDE adapter used to replace the SCSI adapter would be unable to execute the undocumented SCSI command. A proposed modification cannot render the prior art unsatisfactory for its intended purpose. MPEP § 2143.01.

For at least those reasons, Applicant submits that claim 1 is patentable over the references of record, and respectfully requests that the Examiner withdraw the rejection.

Claims 2-5, 7-9 and 21 depend directly or indirectly upon claim 1, and are patentable for at least the reasons discussed above. Applicant asks the Examiner to withdraw the rejections of these claims as well.

Claim 10 is drawn to a machine-readable medium that provides instructions, which when executed by a set of processors, causes said set of processors to perform operations including receiving an open request from a software to access a secure-private partition on an IDE hard drive of a computer system. As discussed in relation to claim 1, neither *Jones* nor *Cripe* provide any teaching or suggestion of such a secure-private partition on an IDE hard drive of a computer system, so they fail to disclose at least that element of claim 10. Furthermore, the references of record use features and protocols that are specific to their respective interfaces (PCMCIA for *Jones* and SCSI for *Cripe*) and that have no obvious counterpart in IDE. For at least those reasons, Applicant submits that claim 10 is patentable over these references and asks the Examiner to withdraw the rejection of that claim.

As to claims 11-15, those claims depend directly or indirectly upon claim 10. For at least the reasons offered in support of that base claim, Applicant believes the dependent claims are allowable as well. The Examiner is requested to withdraw the rejections of claims 11-15.

As to claim 16, that claim recites a system comprising a number of elements, including an IDE controller operatively coupled to a storage controller and a security/privacy software task operatively coupled to the IDE controller, wherein said IDE controller initiates an unlock request to unlock a secure-private partition in response to a valid unlock handshake. As Applicant's previous comments have

suggested, neither of the references of record teach or suggest any devices or operations that involve an IDE controller operatively coupled to a storage controller. Thus, claim 16 is distinguishable over the references at least on the basis of the aforementioned elements of the claimed system. Applicant respectfully requests that the Examiner withdraw the rejection of claim 16.

As to claims 17-19 and 22, those claims depend directly or indirectly upon claim 16, and are patentable for at least the reasons discussed in support of that base claim. Applicant requests that the Examiner withdraw the rejections of these claims as well.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-5, 7-19, 21 and 22, patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

Dated: 2/22, 2005

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

William T. Babbitt
William Thomas Babbitt, Reg. No. 39,591

12400 Wilshire Boulevard Seventh Floor Los Angeles, California 90025 (310) 207-3800	<p style="text-align: center;"><u>CERTIFICATE OF MAILING</u></p> <p>I hereby certify that the correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:</p> <p style="text-align: center;">Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450</p> <p style="text-align: center;"><u>Lillian E. Rodriguez</u> Lillian E. Rodriguez</p> <p style="text-align: right;">2-22-05 February 22, 2005</p>
--	---